

## REMARKS

Applicant hereby requests further consideration of the application in view of the amendments above and the comments that follow.

### I. The § 112 Rejection

Claim 5 stands rejected under 35 U.S.C. § 112. The Action states that the limitation "*the MMS message*" lacks sufficient antecedent basis. Applicant has amended Claim 5 to obviate this rejection.

### II. The § 102(e) Rejections

Claims 1, 3-4, 8, 10, 13, 15-18, 20, 22 and 26 stand rejected as being anticipated by U.S. Patent Application Publication No. 2004/0029636 to Wells ("Wells"). Applicant respectfully disagrees.

First, Wells fails to teach or suggest that "one of the first and second displays is configured to present an operating interface desktop with user selectable menu items" as recited in independent Claims 1 and 15. In addition, Wells is directed to a large, stationary gaming device. Wells, Abstract. Conversely, amended independent Claims 1 and 15 are directed to "a portable communications device."

Therefore, Applicant respectfully submits that Wells fails to anticipate independent Claims 1 and 15 and dependent Claims 3-4, 8, 10, 13, 16-18, 20, 22 and 26, because of the absence of at least the feature(s) noted above.

### III. The § 103(a) Rejections

#### A. Claims 2, 7, 19, 21, 27-31 and 34-36

Claims 2, 7, 19, 21, 27-31 and 34-36 stand rejected as being obvious over Wells in view of U.S. Patent No. 6,130,665 to Ericsson ("Ericsson"). With reference to Claims 2, 19 and 30, the Action concedes that Wells fails to teach that the user can focus on one of the displays by optically altering his/her focus to a focal length corresponding to the desired

display but then states that Ericsson discloses this feature (citing Figure 4 and col. 3, lines 56-67). Similarly, with reference to Claims 7, 21 and 31, the Action concedes that Wells fails to teach that the first and second displays interactively communicate in response to actions by the user but then states that Ericsson discloses this feature (citing Figure 4 and col. 3, lines 56-67). The Action also concedes, with reference to Claim 27, that Wells fails to teach that the terminal is portable, and with reference to Claim 28, that the terminal is wireless, but then states that Ericsson discloses these features (citing Figure 1 and col. 2, lines 29-42). With reference to Claim 29, the Action concedes that Wells fails to teach that the wireless terminal comprises a housing configured to enclose a transceiver that transmits and receives wireless communications signals and that the first and second displays are in communication with the transceiver, but the Action states that Ericsson discloses these features (citing Figures 1 and 2). The Action concludes that it would have been obvious to combine the teachings of Wells with those of Ericsson. Applicant respectfully disagrees.

First, the cited references fail to teach or suggest "an operating interface desktop with user selectable menu items" as recited in independent Claim 29 (as well as independent Claims 1 and 15 and, as discussed later in these remarks, independent Claim 40).

Moreover, the cited references do not teach or suggest that "the second (innermost or lower) display is configured to present" such an operating interface desktop as recited in independent Claim 29 (and dependent Claims 22, 44 and 45 and, as discussed later in these remarks, Claim 40). Indeed, Ericsson describes a keypad positioned over text and, as such, teaches away from the placing an operating interface on the lower display. *See* Ericsson, Figure 4 and col. 3, lines 62-64. Thus, Claim 29 (and Claims 22, 44 and 45) is patentable over the cited references for at least this additional and independently patentable feature.

In addition, the Action appears to employ hindsight reasoning to conclude that the claimed subject matter of the present invention is obvious. However, a teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *See* MPEP §2143.

Further, the fact that the invention employs known elements does not preclude patentability. It is the claimed combination of elements which is the proper basis for review.

“Virtually all inventions are necessarily combinations of old elements.” *Panduit* at 1575 (citing *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 220 USPQ 97, 99-100 (Fed. Cir. 1983)). Indeed, the Federal Circuit has stated (in regard to an obviousness-type invalidity challenge to an issued patent) that “[t]he notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103.” *Panduit* at 1575.

As recently affirmed by the Court of Appeals for the Federal Circuit, to support combining references in a §103 rejection, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement is not met by merely offering broad, conclusory statements about teachings of references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Further, “[i]t is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) (emphasis added). The standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention. *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983). Further, simplicity alone cannot be determinative of obviousness. *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998).

Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Wells with those of Ericsson in a manner that would render the claimed invention obvious absent the teachings of the instant invention. Wells is directed to a large, stationary, wagering gaming device. Wells, Abstract. In fact, Wells teaches a gaming device that includes a floor-supported gaming cabinet or other housing. Wells, paragraph [0008]. On the other hand, Ericsson is directed to a small portable device that is, for example, “no larger than a standard business desk telephone.” Ericsson, col. 2, lines 36-38. Thus, the stationary gaming system of Wells and the wireless portable communications device of Ericsson are very different devices with distinctly different operability and features. One of skill in the art would not have been motivated to combine the large gaming display configuration of Wells with the small screens of a portable

communication device such as that proposed by Ericsson. Indeed, Ericsson describes the use of two overlying screens but configures them to operate in a distinctly different manner from that of the instant invention. There would have been no motivation to modify the display configuration with that of Wells absent the teachings of the instant invention.

Furthermore, even if arguably properly combinable, the cited references would fail to yield the claimed invention. The Action alleges that it would have been obvious to one of ordinary skill to combine the teachings of Wells with those of Ericsson "in order to see and clearly distinguish between the information presented on the two different display screens." The Action, p. 8. However, one can already clearly distinguish between the information presented on the screens of Ericsson. Further, Wells discloses displaying "co-acting or overlapping images" to a player. Wells, paragraph [0051]. Thus, reducing the screen size of Wells to that of Ericsson would appear to make it extremely difficult to "clearly distinguish" between the "overlapping images" proposed by Wells.

Furthermore, Wells discloses displaying "functional images" to a player on a large, stationary, self-contained gaming device. Wells, paragraph [0064]. Thus, Applicant submits that somehow properly combining the teachings and suggestions of Wells with those of Ericsson would yield a gaming device with co-acting or overlapping functional images, not a portable device with an operating interface desktop that is part of a communications network.

In addition, Applicant submits that the dependent claims recite independently patentable subject matter. For example, Wells and Ericsson fail to teach or suggest that "the first display is configured as a substantially transparent (or monochromatic) display and the second display is configured as a color graphic display" as recited in dependent Claim 35 (and dependent Claims 41, 43 and 46).

Therefore, Applicant respectfully submits that independent Claim 29 and dependent Claims 2, 7, 19, 21, 27-28, 30-31 and 34-36 are patentable over the cited references for at least the reasons noted above.

#### **B. Claims 5-6 and 32-33**

Claims 5-6 and 32-33 stand rejected as being obvious over Wells and Ericsson in further view of U.S. Patent Application No. 2005/0195927 to Solonen ("Solonen").

However, as stated above, Wells and Ericsson fail to teach or suggest all of the features of the claimed invention, one of skill in the art would not have been motivated to combine the teachings of Wells with those of Ericsson absent the teachings of the instant invention, and even if combinable, Wells and Ericsson would fail to yield the claimed invention. Moreover, Solonen fails to resolve the deficiencies of the cited references and fails to resolve this lack of motivation. In fact, in Solonen, the image part **201** is adjacent the text part **202** on a single-level display screen. *See* Solonen, Figure 2. Furthermore, no motivation exists to display the image part **201** behind the text part **202** as such a combination would appear to clutter the display **200** and inhibit the user's ability to "chat" with other users as desired by Solonen. *See* Solonen, Figure 2 and paragraph [0030].

Moreover, even combined the cited references do not yield the claimed invention. Ericsson proposes only a "virtual keypad" or a thin overlay which displays a "picture keypad" and states that entered information may be displayed on the same parts of the screen but in "different fashions." Ericsson, col. 1, lines 56-67, col. 3, lines 60-62 (emphasis added). Thus, Applicant submits that the proposed Ericsson keypad is a static display of text over a display with text. Furthermore, Applicant submits that assuming for argument that the cited references could be properly combined, the cited references in combination with Solonen would yield a device that can display a static image of a keypad over an MMS message or a device with an overlapping gaming image rather than a device that can dynamically parse incoming data onto two displays.

Accordingly, Applicant respectfully submits Claims 5-6 and 32-33 are patentable over the cited references for at least these additional reasons.

#### **C. Claims 9, 12 and 23-25**

Claims 9, 12 and 23-25 stand rejected as being obvious over Wells in view of U.S. Patent No. 6,275,932 to Yamaguchi et al. ("Yamaguchi"). With reference to Claims 9 and 23, the Action concedes that Wells fails to teach that the first display operates in a screensaver mode during periods of non-active use, and with reference to Claims 12, 24 and 25, the Action concedes that Wells fails to teach electrically locking access to the device by providing a password restricted access entry region on the first display and optically blocking

the remainder of the first display while the second display carries text and visual data thereon to inhibit unauthorized use of the device. However, the Action also states that Yamaguchi discloses these features (citing col. 11, lines 6-12). The Action then concludes that it would have been obvious to combine the teachings of Wells with those of Yamaguchi to "lock and protect the device from unauthorized users" and "block the information on the second display." The Action, p. 14-15. Applicant respectfully disagrees.

Wells is directed to large, stationary, floor-mounted self-contained device wagering gaming devices, which are often designed to be "engaging and interesting to players" and encourage use from players. *See* Wells, paragraphs [0053], [0057]. Thus, one of skill in the art would not be motivated to lock and protect the device and block information. Wells, Abstract. Yamaguchi, on the other hand, is "for use in an electronic machine such as a portable computer" and uses a single display. Yamaguchi, Figure 1 and col. 1, lines 9-10. Stationary gaming systems and portable computers are quite different devices. Moreover, locking a single display is effective for its intended purpose, and there would have been no motivation to provide an extra display in the Yamaguchi device just to lock a viewer from accessing an inner display. An extra display in Yamaguchi would appear to increase the cost and functional components that interface with one another. Therefore, Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Wells with those of Yamaguchi absent the teachings of the instant invention.

Furthermore, Applicant submits for argument that the references could be properly combined, the cited combination of references would yield a large, stationary, self-contained, wagering gaming device with a screensaver, not the portable communications device as claimed.

Accordingly, Applicant respectfully submits Claims 9, 12 and 23-25 are patentable over the cited references for at least these additional reasons.

#### **D. Claim 11**

Claim 11 stands rejected as being obvious over Wells in view of U.S. Patent No. 6,396,475 to Ellenby et al. ("Ellenby"). The Action concedes that Wells fails to teach that the text is map directions of a geographic location of interest and the image is a map

corresponding to the location of interest. However, the Action also states that Ellenby discloses these features (citing Figure 1). The Action then concludes that it would have been obvious to combine the teachings of Wells with those of Ellenby "to present the text and image of the directions on the separate display screens such that both can be viewed simultaneously." The Action, p. 16. Applicant respectfully disagrees.

In Ellenby, the region 2 that displays the image is next to the region 3 that displays the text 4. *See* Ellenby, Figure 1. Thus, in Ellenby text and images are already displayed simultaneously, and no motivation exists to display region 2 behind region 3 as such a combination would crowd the display over that proposed. *See* Ellenby, Figure 1. Moreover, Wells is directed to a large, stationary, self-contained, wagering gaming device. Wells, Abstract. Ellenby, on the other hand, involves handheld computers, including wireless telephones, with a single-level display. Ellenby, Figure 1 and col. 1, lines 41-47. Stationary gaming systems and wireless telephones are extremely different devices. Therefore, Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Wells with those of Ellenby absent the teachings of the instant invention.

Furthermore, Applicant submits, arguing that the references could be properly combined, the combination of the cited references would yield a large, stationary, self-contained, wagering gaming device that displays a map and text label or a side-by-side display with text and images displayed simultaneously on a portable device, not the portable communications device as claimed.

Thus, Applicant respectfully submits Claim 11 is patentable over the cited references for at least these additional reasons.

#### **E. Claim 14**

Claim 14 stands rejected as being obvious over Wells in view of U.S. Patent No. 5,661,635 to Huffman et al. ("Huffman"). The Action concedes that Wells fails to teach that the textual data is from a digital book or article and that the visual data is video clips, images and/or pictures from the digital book or article but then states that Huffman discloses these features (citing col. 5, lines 34-47). The Action then concludes that it would have been

obvious to combine the teachings of Wells with those of Huffman "to provide a way to view the images and text of the digital book at the same time." The Action, p. 17. Applicant respectfully disagrees.

Wells is directed to a large, stationary, self-contained gaming device. Wells, Abstract. Huffman, however, involves hand-held electronic reading devices. Huffman, col. 2, line 20. Large, stationary, self-contained gaming systems and hand-held electronic reading devices are very different devices. In addition, the Huffman touchscreens **130** and **132** are situated side-by-side as they are "integrated in the book-shaped housing." Huffman, col. 4, lines 61-67. Therefore, in Huffman, text and graphical information can already be viewed at the same time, and no motivation exists to place one touchscreen behind the other as such a combination would appear to impair the user's reading ability over the configuration already in use. *See* Huffman, col. 4, lines 61-67.

Furthermore, Applicant submits that arguing that the references could be properly combined, the cited references would yield a large, stationary, self-contained wagering gaming device with text and graphical information or a book-like device with side-by-side displays, not the portable communications device as claimed.

Thus, Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Wells with those of Huffman absent the teachings of the instant invention. Accordingly, Applicant respectfully submits Claim 14 is patentable over the cited references for at least these additional reasons.

#### **F. Claims 37-39**

Claims 37-39 stand rejected as being obvious over Wells and Ericsson in further view of Yamaguchi. As explained in the discussion regarding Claims 2, 7, 19, 21, 27-31 and 34-36, Wells and Ericsson fail to teach or suggest all of the features of the claimed invention, one of skill in the art would not have been motivated to combine Wells with Ericsson absent the teachings of the instant invention, and even if combinable, Wells and Ericsson would fail to yield the claimed invention. Furthermore, as explained in the discussion regarding Claims 9, 12 and 23-25, Yamaguchi fails to resolve the deficiencies of the cited references and fails to resolve this lack of motivation.

Furthermore, even if combined with Yamaguchi, Wells and Ericsson fail to yield the claimed invention. Applicant submits that arguing that the references could be properly combined, the teachings and suggestions of the cited references would yield a large, self-contained gaming device with co-acting or overlapping functional images and a screensaver or that the user interface display is locked rather than the upper display, not a wireless terminal with a first display configured to operate as a screensaver, block viewability therethrough, or electronically lock access to a second display, while the second display continues to display data.

Accordingly, Applicant respectfully submits Claims 37-39 are patentable over the cited references for at least these additional reasons.

#### **G. Claims 40 and 41**

Claim 40 stands rejected as being obvious over Solonen in view of Wells. While the Examiner does not state that Claim 41 is rejected as being obvious over Solonen in view of Wells, Applicant will assume this was the Examiner's intention as Claim 41 is listed as rejected following the rejection of Claim 40 on page 19. The Action concedes that Solonen fails to teach splitting the text and visual data onto two separate display screens, one being located above the other but then states that Wells discloses this feature (citing Figure 1 and paragraph [0049]). The Action then concludes that it would have been obvious to combine the teachings of Solonen with that of Wells "to simultaneously view different images on different screens." The Action, p. 19. Applicant respectfully disagrees.

First, not only do the cited references fail to teach or suggest that the computer-readable program code comprises "computer readable program code that is configured to display an operating interface with user selectable menu items" (as recited in independent Claim 40), but the cited references also fail to teach or suggest displaying such an operating interface "on the second (innermost or lower) display" (as recited in independent Claim 40).

In addition, Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Solonen with that of Wells absent the teachings of the instant invention. Solonen relates to a communications network terminal and proposes a single-level display configuration. Solonen, Figure 2 and paragraph [0002]. On the other

hand, Wells is directed to a large, stationary, self-contained gaming device. Wells, Abstract. Communications network terminals and stationary gaming systems are extremely different devices with distinctly different operability and features. Moreover, in Solonen, the image part 201 is adjacent the text part 202 on a single-level display. *See* Solonen, Figure 2. Thus, a user can already simultaneously view the image part and the text part, and no motivation exists to display the image part 201 behind the text part 202 as such a combination would appear to clutter the display 200 and inhibit the user's ability to "chat" with other users as desired by Solonen. *See* Solonen, Figure 2 and paragraph [0030].

Moreover, even combined the cited references do not yield the claimed invention. Applicant submits that arguing that the references could be properly combined, the cited references would yield program code for a wagering gaming device or a single level display with gaming code rather than the computer program product for selectively displaying text or visual data of a wireless terminal as claimed.

In view of the foregoing, Applicant respectfully submits independent Claim 40 and dependent Claim 41 are patentable over the cited references.

#### **H. Claim 42**

Claim 42 stands rejected as being obvious over Solonen and Wells in further view of Ericsson. As explained above, Solonen and Wells fail to teach or suggest all of the features of the claimed invention, one of skill in the art would not have been motivated to combine the teachings of Solonen with that of Wells absent the teachings of the instant invention, and even if combinable, Solonen and Wells would fail to yield the claimed invention. Moreover, Ericsson fails to resolve the deficiencies of the cited references and fails to resolve this lack of motivation.

Furthermore, even if combined, Ericsson, Solonen and Wells do not yield the claimed invention. Applicant submits that, assuming that the references could be properly combined, the cited references would yield displaying a static image of a keypad and text adjacent to one another and overlapping a predefined gaming image, not a computer program product including computer program code that provides dynamic interactive communication of incoming signals between a first and second display. Therefore, Applicant respectfully

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submits that Claim 42 is patentable over the cited references for at least these additional reasons.

In view of the foregoing, Applicant respectfully submits that the pending claims are patentable over the cited references for at least the reasons discussed herein above.

#### **IV. New Claims**

In order to form a more complete claim set, Applicant has added new dependent Claims 43-47. The claims are supported by the specification (*see, e.g.*, p. 2, lines 17-19, p. 6, lines 25-33, p. 7, lines 1-13). Entry and consideration of the new claims is respectfully requested.

#### **CONCLUSION**

Accordingly, Applicant submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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#### **CERTIFICATION OF TRANSMISSION UNDER 37 CFR § 1.8**

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office on April 19, 2006.



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